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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

FRONDA, CHRISTIAN L

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/834,722

Applicant(s)

Farwick et al.

Examiner

Christian L. Fronda

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9, and 17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Apr 16, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Applicants' election with traverse of Group I, claims 1-7 and 9, in Paper No. 14 is acknowledged. The traversal is on the grounds that the number of restriction groups is excessive and that the restriction requirement is not correct. This is not found persuasive because a search of all the inventions in the patent literature and the non-patent literature cannot be made without serious burden because the inventions require separate searches that have different limits, boundaries, scope, and subject matter. Because these inventions are distinct for the reasons given above and of record and have acquired a separate status in the art as shown by their divergent subject matter and classification, restriction for examination purposes is proper.

Claims 8, 10-16, 18, and 19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. The requirement is still deemed proper and is therefore made FINAL.

Applicants request to cancel non-elected claims 8, 10-16, 18, and 19 is acknowledged.

2. Claims 1-7, 9, and 17 are under consideration in this Office Action.

### *Claim Rejections - 35 U.S.C. § 112, 1st Paragraph*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 and 17 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claimed invention encompass any polynucleotide that is at least 70% identical to a polynucleotide encoding a polypeptide that contains the amino acid sequence of SEQ ID NO: 2, a polynucleotide that encodes a polypeptide that is at least 70% identical to the amino acid sequence of SEQ ID NO: 2, and a polynucleotide containing at least 15 successive nucleotides thereof. The specification, however, only provides the following representative species encompassed by the invention: an isolated polynucleotide consisting of SEQ ID NO: 1. There is

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no disclosure of any particular structure to function/activity relationship in the single disclosed species. The specification also fails to describe additional representative species of these polynucleotides by any identifying structural characteristics or properties for which no predictability of structure is apparent. Given this lack of additional representative species as encompassed by the claims, Applicants have failed to sufficiently describe the claimed invention, in such full, clear, concise, and exact terms that a skilled artisan would recognize Applicants were in possession of the claimed invention. Claims 2-7 which depend from claim 1 are also rejected because they do not correct the defect of claim 1.

5. Claims 1-3, 5-7 and 17 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for an isolated polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO:2 or an isolated polynucleotide comprising SEQ ID NO: 1; does not reasonably provide enablement for any other embodiment.

Factors to be considered in determining whether undue experimentation is required, are summarized In re Wands [858 F.2d 731, 8 USPQ 2nd 1400 (Fed. Cir. 1988)]. The Wands factors are: (a) the quantity of experimentation necessary, (b) the amount of direction or guidance presented, (c) the presence or absence of working example, (d) the nature of the invention, (e) the state of the prior art, (f) the relative skill of those in the art, (g) the predictability or unpredictability of the art, and (h) the breadth of the claim.

The nature and breadth of the claims encompass any polynucleotide that is at least 70% identical to a polynucleotide encoding a polypeptide that contains the amino acid sequence of SEQ ID NO: 2, a polynucleotide that encodes a polypeptide that is at least 70% identical to the amino acid sequence of SEQ ID NO: 2, and a polynucleotide containing at least 15 successive nucleotides thereof

The specification provides guidance and examples for making an isolated polynucleotide encoding a polypeptide comprising the amino acid sequence of SEQ ID NO:2 or an isolated polynucleotide comprising SEQ ID NO: 1. However, the specification does not teach the specific structural/catalytic amino acids and the structural motifs essential for protein activity/function which cannot be altered. The state of the art as exemplified by Attwood et al. (Comput. Chem. 2001, Vol. 25(4), pp. 329-39) is such that "...we do not fully understand the rules of protein folding, so we cannot predict protein structure; and we cannot invariably diagnose protein function, given knowledge only of its sequence or structure in isolation" (see Abstract and entire publication). Furthermore, Ponting (Brief. Bioinform. March 2001, Vol. 2(1), pp. 19-29) states that "...predicting function by homology is a qualitative, rather than quantitative, process and requires particular care to be taken...due attention should be paid to all available clues to function, including orthologue identification, conservation of particular residue types, and the co-occurrence of domains in proteins" (See Abstract and entire publication).

The standard for meeting the enablement requirement is whether one of skill in the art

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can make the invention without undue experimentation. The amount of experimentation to make the claimed polynucleotide is enormous and entails selecting specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make a polynucleotide that encodes a polypeptide that contains an amino acid sequence that is at least 70% identical to SEQ ID NO: 2 and determining by assays whether the polypeptide has activity. The specification does not provide guidance with respect to the specific structural/catalytic amino acids and the structural motifs essential for enzyme structure and activity/function which must be preserved. Thus, searching for the specific nucleotides to change (deletion, insertion, substitution, or combinations thereof) in a polynucleotide to make a polynucleotide that encodes a polypeptide that contains an amino acid sequence that is at least 70% identical to SEQ ID NO: 2 is well outside the realm of routine experimentation and predictability in the art of success in determining whether the resulting polypeptide has activity is extremely low since no information is provided by the specification regarding the specific catalytic amino acids and the structural motifs essential for enzyme structure and activity/function which must be preserved.

The Examiner finds that one skilled in the art would require additional guidance, such as information regarding the specific catalytic amino acids and the structural motifs essential for activity/function which must be preserved. Without such a guidance, the experimentation left to those skilled in the art is undue. Claims 2-7 which depend from claim 1 are also rejected because they do not correct the defect of claim 1.

6. Claim 9 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The invention appears to employ a novel gene and vector. Since the vector is essential to the claimed invention, it must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. The claimed plasmids' sequences are not fully disclosed, nor have all the sequences required for their construction been shown to be biblically known and freely available. The enablement requirement of 35 U.S.C. 112, first paragraph, may be satisfied by deposit of the plasmid or transformed E. coli. The specification does not disclose a repeatable process to obtain the vectors and it is not apparent if the DNA sequences are readily available to the public. Accordingly, it is deemed that a deposit of the plasmid should have been made in accordance with 37 C.F.R. 1.801-1.809.

It is noted that the applicant has deposited the transformed E. coli strain DSM 14080, but there is no indication in the specification as to public availability. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by the applicant, or a statement by an attorney of record over his/her signature and registration number, stating that the specific microorganism has been deposited under the Budapest Treaty and that the strain will be irrevocably and without restriction or condition released to the public upon the issuance of the

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patent, would satisfy the deposit requirement made herein.

If the deposit has not been made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 C.F.R. 1.801-1.809 and MPEP 2402-2411.05, the applicant may provide assurance or compliance by an affidavit or declaration, or by a statement by an attorney of record over his/her signature and registration number, showing that:

- (1) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (2) all restriction upon availability to the public will be irrevocably removed upon granting of the patent;
- (3) the deposit will be maintained in a public repository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and
- (4) the deposit will be replaced if it should ever become inviable.

***Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-7 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 the phrase "identical to the extent of at least 70% to a polynucleotide which codes for a polypeptide which comprises the amino acid sequence of" SEQ ID NO: 2" is vague and indefinite because the specific nucleotide sequence to which the claimed polynucleotide has 70% identity to is not known and not defined in the specification. Furthermore, the phrase "the polypeptide preferably having the activity of O-succinylbenzoic acid CoA ligase" renders the claim vague and indefinite because it is not known if the claimed polypeptide has the recited activity. Claims 2-7 and 17 which depend from claim 1 is also rejected because they do not correct the defect of claim 1.

In claim 2 the phrase "preferably recombinant" renders the claim vague and indefinite because it is not known if the claim polynucleotide is or is not further limited to a recombinant polynucleotide.

In claim 5 ii), the phrase "within the region of degeneration of the genetic code" renders the claim vague and indefinite because the meaning of the phrase is not known and not defined in the specification. In part (iii), the hybridization conditions are not recited and not known and thus render the claim vague and indefinite. In part (iv) the phrase "functionally neutral sense

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mutations" is vague and indefinite because the meaning of the phrase is not known and not defined in the specification.

Claim 6 is vague and indefinite because the specific temperature for the hybridization is not recited in the claim.

***Claim Rejections - 35 U.S.C. § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Du (Accession AD0000004).

Du (Accession AD0000004) teach a polynucleotide that contains at least 15 successive nucleotides encoding SEQ ID NO: 2 (see attached alignment). Thus, the reference teachings anticipate the claimed invention.

11. Claims 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (Accession U15187).

Smith (Accession U15187) teach a polynucleotide that is expected to hybridize to SEQ ID NO: 1 since no stringent hybridization conditions have been recited (see attached alignment). Thus, the reference teachings anticipate the of claimed invention.

***Conclusion***

12. No claim is allowed.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

CLF

